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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,834	07/15/2003	Claude Grison	33808F0764	5932

441 7590 02/08/2005

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EXAMINER

MOORE, MARGARET G

ART UNIT PAPER NUMBER

1712

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,834

Applicant(s)

GRISON ET AL.

Examiner

Margaret G. Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 42 to 46 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 42 to 44 is/are rejected.
- 7) ☒ Claim(s) 45 and 46 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/715,915.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 42 to 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 250 229.

EP teaches catalysts including silacyclics. See the formulas shown on page 3, lines 10 to 20. The third formula shown differs from that claimed only in that it contains tetramethylene backbone forming the cyclic group rather than a pentamethylene group forming the cyclic backbone.

This difference, however, would have been obvious to one having ordinary skill in the art for, at least, two different reasons. First note that n can be from 4 to 6, while only an n value of 4 is shown. However in view of the fact that '229 teaches that n values of 4, 5 and 6 can be used in the alternative with the expectation of comparable results, the skilled artisan would have found the silacyclohexane required by this claim obvious. On the other hand, note that tetramethylene and pentamethylene are adjacent members of a homologous series. Compounds which are position isomers (compounds having the same radicals in physically different positions on the same nucleus) or homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by $-\text{CH}_2-$ groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. In view of this claim 42 is rendered obvious. With regard to claims 43 and 44, note that " n " in the substituent group (line 8, page 3) can be from 1 to 5, suggesting a value of 2. Selecting the value of 2 from small range of 1 - 5 would have been within routine experimentation for the skilled artisan. In other words, replacing the exemplified methyl groups with an ethyl group would have been obvious to the skilled artisan since such compounds are indicated as being functionally equivalent and used in the alternative by the prior art.

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3. Claims 45 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art fails to teach or suggest a process of making the dialkoxysilacyclohexane as claimed. EP 250 229 does not provide a specific means of making these compounds. Hersh teaches a method of making silacyclic compounds, the generic formula of which embraces the compound in claim 42 (though the Examiner has not made an obviousness rejection over this rejection since the teachings in the EP patent are significantly closer to the claims than Hersh). In this reference patentees react a chlorosilane to form a silacyclic compound having SiCl groups. Column 8 shows a subsequent reaction between the SiCl groups with an alcohol to form groups corresponding to OX and OY in the instant claims. As such there is not adequately motivation to select a tetraalkoxysilane as required in claim 45 to prepare a dialkoxysilacyclohexane meeting the formula in claim 42.

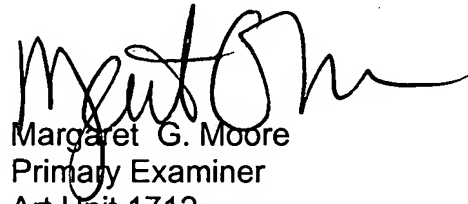
4. The Examiner cites Hoppin et al. as being of general interest. This is the US equivalent of EP 250 229, but does not show complete formulas for the silacyclic compounds relied upon in this rejection (due, apparently, to a printing error).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
2/6/05